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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,447	04/12/2007	Christian Funke	2400/0450000/VLC	2172
26111 7590 02/26/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER MAEWALL, SNIGDEHA				
ART UNIT		PAPER NUMBER		
1612				
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02/26/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/581,447

**Applicant(s)**

FUNKE ET AL.

**Examiner**

Snigdha Maewall

**Art Unit**

1612

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 10/30/09

### **DETAILED ACTION**

1. Receipt of Applicants arguments/Remarks and IDS filed on 10/30/09 have been acknowledged.

Receipt of Applicants declaration filed on 10/30/09 is also acknowledged.

Applicant had elected a composition with specific insecticide flonicamid from group 2 (2-6) and an anthranilamide of formula II (II-1) to be prosecuted.

Claims 15-16 do not read on the original elected species and thus are excluded from prosecution as being not elected by original presentation. Primicarb was not elected by original presentation; as such the claims drawn to Primicarb were not included in prosecution.

Claims **12-14** are under prosecution based on the originally elected species to be prosecuted.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Lahm et al (WO 03/015518 A1, presented in IDS).

Applicants claim a synergistically effective composition containing a compound (I-a-4) of formula I or flonicamid (2-6) of group II and compound (II-1) of formula II.

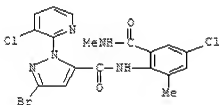
Lahm et al teach a method for controlling particular insect pests by applying their anthranilamide compounds. They also teach use of one or more other biologically active compounds or agents including insecticides, fungicides etc. including **flonicamid** (Page 96, lines 23-25 and 37).

The reference teaches anthranilamide derivative of following formula in their example 11 (Page 42, lines 18-20).

**EXAMPLE 11**

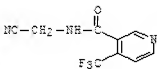
Preparation of 3-Bromo-N-[4-chloro-2-methyl-6-[(methylamino)carbonyl]phenyl]-1-(3-chloro-2-pyridinyl)-1H-pyrazole-5-carboxamide

Corresponds to following structure



Lahm et al disclose use of one or more other biologically active compounds or agents including insecticides, fungicides etc. including **flonicamid** (Page 96, lines 23-25

and 37) of the following structure in their composition containing anthranilamide derivatives.



The reference teaches use of their compounds as a formulation or composition containing active ingredients 5-90 weight percent granules, tablets and powders. The reference does not specifically teach the ratio of individual active ingredient, it is the position of the Examiner that it will be at least a ratio of 1:1 (Page 89, line 18) and this includes compound of group 2 and anthranilamide of formula II ratio from 500:1 to 1:50 as claimed by instant claim 13. additionally, optimization of amounts would be within the purview of a skilled artisan absent evidence of any criticality shown with the claimed amount. The reference teaches suitable carrier comprising a solid diluents or surfactant (Page 89, lines 1-3). The reference thus teaches use of composition containing anthranilamide derivatives, insecticide and a surfactant.

The specific combination of features claimed is disclosed within the broad generic ranges taught by the reference but such "picking and choosing" within several variables does not necessarily give rise to anticipation. Corning Glass Works v. Sumitomo Elec., 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables (various

insecticidal active compounds such as buprofezin, flonicamid and primicarb), anticipation cannot be found.

That being said, however, it must be remembered that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". KSR v. Teleflex, 127 S.Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is... a person of ordinary creativity, not an automaton." Id. at 1742.

Consistent with this reasoning, it would have obvious to have selected various combinations of various disclosed ingredients (various insecticidal active compounds such as buprofezin, flonicamid and primicarb) from within a prior art disclosure, to arrive compositions "yielding no more than one would expect from such an arrangement".

### ***Response to Arguments***

4. Applicant's arguments filed 10/30/09 have been fully considered but they are not persuasive.

Applicant argues that Lahm recites laundry list of potential mixing partners without any synergism and the claimed ratio is not taught by the prior art.

While it is true that Lahm discloses several compounds however, as stated in the rejection above that when a patent simply arranges old elements with each performing the same function it had been known to perform and yield no more than one would expect from such an arrangement. Therefore, while applicants contend that no synergism is shown in prior art, it is the position of the examiner that such property would flow from the combination of the two insecticidal compounds. Regarding the 1:1 amount, it is the position of the examiner that since the amount of active ingredients are shown to be from 5-90 weight percent, one of ordinary skill can optimize such amounts; the claimed amount is very broad. Besides, the declaration shows synergistic effect with only specific amount wherein the claimed amount is much broader in scope than the declaration provided. Applicants argue the synergism shown as evidence to overcome the obviousness rejection, however as discussed below the declaration does not commensurate with the scope of claims. The declaration provides results with specific ratio. Additionally, the results are not clear as to which anthranilamide has been tested. The formula in declaration does not coincide with the formula recited in claims.

***Response to Declaration***

The declaration under 37 CFR 1.132 filed 10/30/09 is insufficient to overcome the rejection of claims 12-14 based upon the obviousness rejection as set forth in the last Office action because: It is not clear in Table A which active ingredients are encompassed under II-4, no specific anthranilamides are disclosed with specific substituents. Claim 12 as recited lists formula for anthranilamide as (II-I) and there are various substituents that are shown in claim, therefore it is unclear as to what specific compound or compounds is the applicant referring to. Furthermore the declaration shows concentration with specific amounts and claims recite weight ratio which is quite broad, thus the declaration does not provide result for the full scope of the claims. In table I, it is not clear which compound is the active ingredient II-1-54 and II-1-12 is referring to, similar is the case with active ingredient II-1-9 in table B4; the specific substituents of formula of compound are not defined. The declaration is deficient in that Dr. Andersch has not provided data commensurate in scope to the instantly claimed invention, e.g., the compounds of anthranilamides of the formula (II-I). Confusingly, the Examiner cannot independently analyze the data, as a whole, without these pertinent results. The declaration refers only to the system described *supra* and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.



**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**6.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Snigdha Maewall whose telephone number is (571)-272-6197. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0580. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Snigdha Maewall/

Examiner, Art Unit 1612

/Gollamudi S Kishore/

Primary Examiner, Art Unit 1612